

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Daniel J. SCALES, et al.)	Group Art Unit: 2452
Serial No.:	10/665,779)	
Filed:	September 19, 2003)	Examiner: Chankong, Dohm
Title:	Storage Multipath Management)	
	In a Virtual Computer System)	Confirmation No. 6408
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Attorney ref: A032

Date: May 7, 2009

Mail Stop Amendment
Commissioner for Patents

PETITION TO THE DIRECTOR
IN ACCORDANCE WITH 37 C.F.R. § 1.181

Dear Sir:

Applicants respectfully petition the Director to review the objection to the specification in the present Application and grant relief requested.

STATEMENT OF FACTS

On 02/25/2008, Applicants introduced claim 37 and dependent claims to “A computer program embodied in a computer-readable medium.”

On 06/05/2008, an Office Action was issued that included an Objection to the specification under 37 C.F.R. § 1.75(d)(1) (hereinafter, “Rule 75(d)”) stating that “claims 37-48 are rejected for reciting a ‘computer program’ and a ‘computer-readable medium’ but Applicant’s specification fails to provide any description for these terms.”

On 10/02/ 2008, Applicants submitted, in response to the 06/05/2008 Office Action, an Amendment that modified claim 37 and dependent claims to read, “A tangible computer readable medium embodying a computer program.” Applicants argued that the objection to the specification under Rule 75(d) was improper for a variety of reasons which are presented below in detail.

On 12/24/2008, a new Office Action was issued. This Office Action contains, on pages 2-3 thereof, an objection to the specification as follows:

“The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d) and MPEP § 608.01(o). Correction of the following is required: claims 37-43 and 54-58 recite a “tangible computer readable medium.” This term is not described in Applicant’s specification. This rejection is necessary in order to properly determine whether the term meets the requirements under § 101. To overcome this rejection, rather than simply reciting sections from the MPEP, Applicant need only point to the section of the specification which provide the “clear support . . . so that the meaning of the terms in the claims are ascertainable by reference to the description.”

On 03/17/2009 and 03/18/ 2009, the undersigned spoke with the Examiner responsible for this case, but was unable to resolve the legal issues in this matter. In this conversation, the Examiner suggested that removal of the term, “tangible” would overcome this objection. In explaining the § 101 concern, the Examiner suggested that the term, “tangible,” lacking adequate definition or explanation in the specification, might read on a signal propagating in a copper wire, which, although tangible, would not be considered to be statutory subject matter under 35 U.S.C. § 101.

Applicants concurrently submits herewith an Amendment modifying claim 37 (and dependent claims) to read, “A computer readable storage medium embodying a computer program.” Although Applicants have removed “tangible” by this Amendment, this does not resolve the legal issue of the objections under Rule 75(d), since the issue of whether a claim term must appear or be explained in the specification remains.

Applicants stipulate that the terms “tangible computer readable medium,” “computer program,” “tangible,” “medium,” “computer readable medium,” etc., do not currently appear in

the written description, but nevertheless assert that appearance of such terms in the claims is (or would be) entirely appropriate.

Furthermore, the Assignee of the present Application has received, in other Applications, similar improper objections under Rule 75(d). See, e.g., the 01/26/2009 Office Action in U.S. Patent Application 10/665,808. In discussions with outside attorneys, undersigned has learned that they have also received a number of improper objections under Rule 75(d) for other clients.

ARGUMENT

The issues addressed herein are: (1) what is the appropriate test to determine whether an objection to the specification on the basis of Rule 1.75(d) is appropriate, and (2) does the present Application meet the requirements of that test.

1. The test to determine whether an objection to the specification on the basis of Rule 75(d) is appropriate.

Applicants submit that if the meaning of the terms in the claims would be readily ascertainable by a person having ordinary skill in the art with a reasonable degree of certainty and precision upon reading the specification, then an objection under Rule 75(d) is improper.

Rule 75(d) states:

“The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

In the 12/24/08 Office Action, the Examiner also relied on MPEP 608.01(o), which includes some explanation of Rule 75(d), and, similar to Rule 75(d), states that:

“The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies.”

Initially worth noting is that these sections do not contain an explicit requirement that each term or phrase used in the claims be matched with an antecedent in the specification, only

that such terms and phrases “find clear support . . . so that the meaning of the terms in the claims are ascertainable by reference to the description” (emphasis added). As stated in MPEP 2173.05(e),

“The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision” (emphasis added).

Thus, MPEP 2173.05(e) clarifies Rule 75(d) by indicating that the minimum “support” requires neither antecedent, nor explanation, nor definition of the claim term in question. Instead, MPEP 2173.05(e) states quite clearly that “[t]here is no requirement that the words in a claim must match those used in the specification” and that Rule 75(d) only requires that the terms and phrases define the invention “with a reasonable degree of clarity and precision.” Since there is no requirement that the terms even appear in the written description, the phrases, “find clear support . . . in the description” and “ascertainable by reference to the description” of Rule 75(d) as interpreted by MPEP 2173.05(e) do not require that each term in the claims appear in the written description.

Having identified what Rule 75(d) does not require, we turn now to what Rule 75(d) does require. The only guidance given to Applicants with respect to Rule 75(d) are the following useful phrases: “clear support . . . in the description;” “ascertainable by reference to the description;” and “apparent from the descriptive portion.” Since MPEP 2173.05(e) (quoted above) explains that the terms in the claims need not have matching terms in the specification, and it is *simply not possible to derive the meaning of a term from the written description alone when the term does not appear in the written description*, there must be some other source of information that, combined with the written description, allows one to identify the meaning of the claim term to a reasonable degree of clarity and precision. Thus, when Rule 75(d) states that the term must have “clear support” or have meaning that is “readily ascertainable” from the written description, it is also true that the written description need not stand alone in providing the support or meaning.

Instead, the Office can rely on the knowledge and experience of the person having ordinary skill in the art to which the written description pertains. The Federal Circuit held that “[d]uring examination, . . . ‘claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art’” (*In re American Academy of Science Tech Center* 70 USPQ2d 1827 1830 (Fed. Cir. 2004) (internal citations removed) (emphasis added). Thus, if the specification is directed to a particular field of endeavor, all the knowledge and experience of the person of ordinary skill in that field may be called upon to determine whether the meaning of the term in the claim is clear to the requisite “reasonable degree of clarity and precision.” Therefore, the appropriate test to determine whether a claim term is adequately supported by the specification, is whether the person of ordinary skill in the art would be able to ascertain the meaning of the claim term with a reasonable degree of clarity and precision upon reading the specification.

At a minimum, the specification provides a context by which a term may be interpreted. For instance, a particular term such as “plasma” may have one well understood meaning in the field of biology, and another in physics. Being well defined in their respective fields, in neither case should an Applicant be required to identify the meaning of the term. In this case, the meaning of “plasma” can be ascertained from the written description even though it does not appear in the written description. This rule—that the specification is not required to include a dictionary definition or explicit antecedent for each claim term—is consistent with the policy of not requiring unnecessary and extraneous matter relating to well-understood concepts or principles in patent applications.¹

Therefore, if the meaning of a term could not be ascertained to a reasonable degree of clarity and precision from the descriptive portion of the specification by a person of ordinary skill in the art, then Applicants concede an objection under Rule 75(d) may be appropriate. This does not mean that the specification must include an explanation or definition, or even antecedent, for each claim term, but instead, only that the terms must be understood by the person of ordinary skill in the art upon reading the specification. However, if the claim term is clear and definite, i.e., its meaning is clear to a reasonable degree of clarity and precision, then such an objection to the specification should not be made.

¹ *Evans v. Eaton*, 20 U.S. 356 (S.Ct. 1822) (“[t]he law does not require of patentees to describe new and old, but merely to distinguish new from old. Otherwise a patent would be more complex and voluminous than a Welsh pedigree”).

2. *Does the present Application meet the requirement of Rule 75(d)*

In the present Application, claim 37 sets forth, *inter alia*, “A computer readable storage medium embodying a computer program,” which, prior to the Amendment filed concurrently with the present Petition, read, “[a] tangible computer readable medium embodying a computer program.” As stipulated in the Statement of Facts above, the terms or phrases, “tangible computer readable medium,” “computer program,” “tangible,” “medium,” and “computer readable medium” do not appear in the written description.

Applicants note that Office Actions issued for the present Application do not reject the subject claims under 35 U.S.C. §112, second paragraph for being indefinite, nor is the specification objected to under 35 U.S.C. §112 for lacking support for these terms under the first paragraph Written Description requirement. These facts suggests acknowledgement by the Office that Applicants indeed had possession of the concepts of “tangible,” “computer program,” and “computer-readable medium” at the time the application was filed, and further, that the meanings of these terms are sufficiently clear and definite to meet 35 U.S.C. §112, second paragraph requirements. It therefore appears that on the one hand the Office acknowledges that the claims are clear and definite, under 35 U.S.C. §112, second paragraph, and on the other hand, have meanings that are not readily ascertainable from the specification. These two positions can only be reconciled by supposing that the Office is now placing an enhanced burden on Applicants beyond the 35 U.S.C. §112 second paragraph requirement by requiring that claim terms not only be clear and definite, but also that each claim term be defined or explained by the specification alone. As established above, however, Rule 75(d) does not include such a requirement.

Instead, the appropriate standard is whether the person of ordinary skill in the art would be able to ascertain the meaning of the claim term from the written description with a reasonable degree of clarity and precision. As the present Application is directed to a sophisticated computer program application for handling a multipath storage system by a server that may have a plurality of virtual machines executing thereon, the person of ordinary skill in the art is certainly aware that computer programs are typically stored on (or embodied by) tangible computer-readable media such as computer disks or other memories. Therefore, the person having ordinary skill in the art would have no trouble ascertaining the meaning of these terms from the specification with more than reasonable degree of clarity and precision. Applicants respectfully submit that, because the terms, “tangible,” “medium,” “storage medium,” “computer

program,” “computer-readable medium,” etc., are well-known terms of art in the field of computer software to which the application is directed, the written description need not provide yet another well known definition or provide antecedent to these terms. The person of ordinary skill in the art would have recognized from the context provided by the specification the meaning of the claim terms “tangible,” etc., with a reasonable degree of clarity and precision. Therefore, the objection to the specification on the basis of Rule 75(d) in the present Application is improper and should be withdrawn.

RELIEF REQUESTED

Applicants accordingly and for the reasons specified above respectfully petition the Director to (1) order the withdrawal of the outstanding objection to the specification and (2) establish clear guidance to all Examiners in the Technology Center as to when an objection under Rule 75(d) is appropriate.

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Respectfully submitted,

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